

## REMARKS

These remarks are in response to the Office Action mailed on October 30, 2002, and for which a three-month extension is hereby requested. The Office Action rejected claims 87-90 under 35 U.S.C. 112. Although the Applicants do not agree with the substance of the U.S.C. 112, first paragraph, rejection and believe that, as used, the terms "signal" and "command" are largely equivalent and that the specification is enabling for either language, claim 87 has been amended to read "initial reset command", thereby making its language uniform with that of its dependent claims and conforming with the comments of the Office Action. The Applicants thank the Examiner for noting the inconsistency between the claims.

The Office Action also rejected claims 87-103 under either 35 U.S.C. 102(e) as being anticipated by Estakhri *et al.* (U.S. patent number 6,182,162) or under 35 U.S.C. 103(a) with Estakhri as the sole reference. The present response is accompanied by Declarations under 37 CFR 131 showing that the present invention as presented in the pending claims was reduced to practice prior to the filing date of the Estakhri *et al.* patent, thereby overcoming the rejections based upon this patent.

### Declarations under 37 CFR 131

Claims 87-103 were all rejected either under 35 U.S.C. 102(e) as being anticipated by Estakhri *et al.* or under 35 U.S.C. 103(a) with Estakhri as the sole reference. The filing date of the Estakhri patent is March 2, 1998, less than one year prior to the filing date of the present application. The present Response is accompanied by a Declaration under 37 CFR 1.131 by each of the inventors named in the present application, Thomas N. Toombs and Micky Holtzman, and supporting documents (Attachments A and B) showing that the invention of the present application as embodied in claims 87-103 was conceived reduced to practice prior to March 2, 1998, thereby overcoming the rejection of these claims.

More particularly, the device claim of independent claim 87 describes a memory card that selects the protocol of a host to which it is connected based upon the initial commands received from the host. Independent claim 91 is a claim for a system including the host as well as a card such as that of claim 87, and independent claim 97 is a method claim corresponding to claim 87. As presented in paragraphs 5-7 of the Declaration of Thomas N. Toombs and paragraph 4 of Micky Holtzman, the card embodiment of claim 87 was reduced

to practice prior to March 2, 1998. Consequently, claims 91 and 97 were reduced to practice prior to March 2, 1998, as they are corresponding system and method claims.

Dependent claims 88-90, 92-96, and 98-103 respectively have claims 87, 91, and 97 as their base claim. These claims also relate to aspects of the embodiment to which the independent claims are drawn and were therefore reduced to practice prior to March 2, 1998. Therefore, a rejection of claims 87-103 either under 35 U.S.C. 102(e) or under 35 U.S.C. 103(a) based upon the cited Estakhri *et al.* patent is overcome by the Declarations.

#### Conclusion

For these reasons, claims 87-103 are believed allowable. Consideration of these claims is therefore respectfully requested and an early indication of their allowability is earnestly solicited.

Respectfully submitted,



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## APPENDIX

### Marked-up Version of Amended Claim:

87.(Amended) A memory card connectable to a master operating in a first communication protocol, comprising:

an interface for connection to the master for the transfer of data and commands between the host and the memory card;

a memory section for storing said data; and

an interface controller connected to the memory section and the interface, wherein the interface controller selects said first communication protocol from a plurality of protocols based solely on an initial reset [signal] command received from the master upon connection to the master.

### Pending Claims

(Claims 1-86 have been cancelled)

87.(Amended) A memory card connectable to a master operating in a first communication protocol, comprising:

an interface for connection to the master for the transfer of data and commands between the host and the memory card;

a memory section for storing said data; and

an interface controller connected to the memory section and the interface, wherein the interface controller selects said first communication protocol from a plurality of protocols based solely on an initial reset command received from the master upon connection to the master.

88. The memory card of claim 87, wherein the interface comprises a plurality of connection pins and wherein said initial reset command comprises asserting a first signal level to a first connection pins when the host operates in the first protocol and not asserting said the first signal level to the first connection pins when the host does not operate in the first protocol.